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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/632,139	08/03/2000	Ryoichi Imanaka	MAT-3720US4	2101

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05/07/2007

EXAMINER

BROWN, RUEBEN M

ART UNIT	PAPER NUMBER
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2623

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/632,139	IMANAKA, RYOICHI	
	Examiner	Art Unit	
	Reuben M. Brown	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14, 17-22, 37, 40-42, 44-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14, 17-22, 37, 40-42, 44-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 14, 17-19, 21-22 & 37 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendments recites, 'recording of said information in said medium is permitted if a value of an identifier read from said medium is an approved ID value, recording of said information in said medium is prevented if any approved ID value is not readable from said medium'. It is noted that claims 17-19, 21-22 & 37, substantially recite that same feature.

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On page 8 of applicant's response (12/11/2006), applicant points to col. 8, line 22 as supporting the claimed feature. Also applicant includes a document entitled, Status and Support of Claims of this Amendment, in which col. 8, lines 21-30 are cited as support for the instant amendment.

However, examiner respectfully points out that cited portion of the specification states, "the descramble apparatus certifies **whether the medium in which the information was written** has an approved ID number and only reading from the medium certified by the descramble apparatus, the descramble apparatus performs normally", emphasis added. Thus the cited portion of the specification is directed to determining the status of a medium after information has been recorded to the instant medium, and does not teach a step directed to conditionally recording on the medium, as a result of the detected status of an approved ID, as recited in the claims.

It is pointed out that col. 7, lines 30-65 discloses, "Therefore, unless all of the recording/reproducing apparatus ID number, the subscriber's ID number and the title name of the recorded program are registered, the subscriber can neither record the audio/video information in the recording/reproducing apparatus 41 nor watch the program on the TV receiver". However, the instant disclosure is specifically different from the recited feature of the claimed 'approved ID value', because it does not explicitly disclose that any of the cited ID's is the 'approved ID value'.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 14-15, 17-19, 21-22 & 37-40 & 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horton, (U.S. Pat # 4,945,563) in view of Yarbrough, (U.S. Pat # 4,598,288).

Considering amended claim 14, the claimed computer information system comprising a provider for providing information to a recipient reads on the central office connected to the cable TV or satellite distribution system, see col. 3, lines 61-68. The additional claimed feature

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of the 'provider charging a different amount to the recipient depending upon whether the information is recorded' reads on the disclosure of Horton that subscriber's may preview a movie free-of-charge, may be charged a certain amount for viewing the movie and a different amount is charged when the movie is ordered for recording, col. 2, lines 25-67; col. 3, lines 40-55 & col. 4, lines 21-34.

Horton does not teach the amended claimed feature that the recording of information in the medium, 'is permitted if a value of an identifier read from the recording medium is an approved value, recording of the information in the medium is not permitted if any approved ID value is not readable from the medium'. Nevertheless, Yarbrough discloses at least two embodiments that read on this feature. First, it is disclosed that if the receiver system detects that a downloaded transmission is copyrighted or otherwise privileged, that the microprocessor 15 will confirm that there is an order for the instant broadcast program stored in RAM 13, before the broadcast program can be recorded, col. 5, lines 24-44.

Secondly, Yarbrough teaches enabling the microprocessor 15 to verify that the rightful apparatus is receiving the broadcast program. This is done by comparing terminal identification information attached to the broadcast program, with the actual identification information of the receiving apparatus, col. 6, lines 20-36. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Horton with the technique of only recording downloaded information after verifying an approved recording medium being identified, at least for the desirable advantage of preventing unauthorized access to the broadcast

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program, as taught by Yarbrough, col. 2, lines 9-50; col. 3, lines 7-17; col. 3, lines 32-55; col. 4, lines 1-20.

As for the claimed computer information system, Yarbrough discloses that the user system includes a microprocessor 15, ROM 17 and RAM 13, (Fig. 1).

Considering claim 17, the claimed steps of a method for processing information corresponds with subject matter mentioned above in the rejection of claim 14, and are likewise rejected.

Considering claim 18, the claimed elements of a method for processing information corresponds with subject matter mentioned above in the rejection of claim 14, and are likewise rejected. As for the different feature of receiving information from a provider, the receiver system of Horton, meets the claimed subject matter, (Fig. 1; col. 3, lines 31-45). Also, in Yarbrough the broadcast program is received from a provider.

Considering claim 19, the claimed elements of a computer information system that corresponds with subject matter mentioned above in the rejection of claim 14, are likewise rejected. As for the different feature of a recipient for receiving information from a provider, the receiver system of Horton, meets the claimed subject matter, (Fig. 1; col. 3, lines 31-45).

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Considering claim 21, the claimed signal transmitted from a recipient of information to a provider of information, such that the signal indicates whether the information is recorded in a medium, is met by the disclosure in Horton that the decoder 28 could provide billing information to the store and hold circuit 46, which is then transmitted to the proper billing authority, see col. 3, lines 35-60. The instant billing information shows which viewing mode was selected by the subscriber, and thus what charges are being billed.

Considering claim 22, the claimed steps of a method for processing information corresponds with subject matter mentioned above in the rejection of claim 21, and are likewise rejected.

Considering claim 37, the claimed elements of an information receiver, correspond substantially with the subject matter mentioned above in the rejection of claims 14 & 19, and are likewise rejected.

Considering claim 40, the claimed 'informing designating unit designate the information', is broad enough to the read on the decoder 28, that decodes the coded information and provides an indication to the user of the various modes of the particular decoded program, see Horton, col. 3, lines 35-42.

Considering claim 42, the information processed and viewed in Horton and Yarbrough is audio/video information.

Considering claims 44, 46, 48, 50, 52, 54 & 56, Yarbrough teaches that the invention is operable with various types of recording apparatus, such as video disc or floppy disc, col. 7, lines 55-68, which reads on the claimed 'non-sequential accessible medium'.

Considering claims 45, 47, 49, 51, 53, 55, & 57, 'wherein the approved ID value is provided by the provider', Yarbrough teaches that the provider provides an authorization code shortly before or along with the program to be recorded, col. 4, lines 35-56; col. 5, lines 1-5; col. 6, lines 50-60.

5. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horton & Yarbrough as applied to claim 37 above, and further in view of Lindman, (U.S. Pat # 4,882,752).

Considering claim 41, even though both Horton & Yarbrough discuss the use of identifiers, the references do not discuss the additionally claimed feature of, 'an informing unit to inform that the identifier is wrong, if the identifier is not registered'. Nevertheless, Lindman (col. 9, lines 10-47; col. 10, lines 62-68 thru col. 11, lines 1-15 & Fig. 5) provides a teaching of informing a user of terminal 12a or 12b, when the personal ID code entered is not registered for authorization to use the system. It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the combination of Horton & Yarbrough with the feature of informing a user when their personal ID is not authorized to access the system, at least

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for the desirable purpose of warning the operator that further communication is not authorized, as taught by Lindman, col. 9, lines 40-47.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) Garfinkle Teaches preventing access to video data based on conditions, and that invention is operable with hard disk, flash tape and/or optical memory, col. 3, lines 10-20.

B) Walker Teaches controlling access to video data based on a terminal ID.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:


(571) 273-7290 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reuben M. Brown M. Brown whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F(8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Reuben M. Brown


HA TRAN
PRIMARY EXAMINER